

REMARKS

Anticipation

The Office considered Claims 1, 12, 18, 19, and 21 to be anticipated by Tomiyasu (US 6134187). The applicant disagrees.

The *sine qua non* of a claim rejection anticipation is that a single reference satisfies every element of the rejected claim. Tomiyasu fails to do that. Independent claims 1, 18, and 21, for example, each recite "a matter management system...." Independent claim 12 recites "a computer implemented matter management system...." At the term requires, and as is clearly supported by the specification, a "matter management system" must at the very least include matter identifiers (i.e. matter numbers, titles, and the like) and textual hours entries corresponding to those matters.

Tomiyasu does neither. Tomiyasu merely teaches a clock. It fails to teach anything at all to do with matters or hours records. Indeed, Tomiyasu does not even contain the terms "matter" or "hours" or anything equivalent. It merely teaches a clock. Because Tomiyasu fails to teach all of the limitations of any of the rejected claims, those rejections are improper and must be withdrawn.

With specific reference to claim 1, some examiners would take the position that the term "matter management system" does not comprise a patentably distinct limitation because the wording is included in the preamble. But that position would be incorrect. In general, a preamble limits the claimed invention if it recites essential structure or steps, or if it is necessary to give life, meaning, and vitality to the patent claim. *In re Cruciferous Sprout Litigation*, 301 F.3d 1343 (Fed. Cir. 2002); (*rehearing and rehearing en banc denied*). In our case the title of the application, the references to the various competing matter management systems, "Timeslips™, QuickBooks™ and CTS™ by FlexTrac Systems, Inc., Dimension™ by Computrac, Inc. and Junior Partner™ for Windows™ by Millenium Software Ltd.", and indeed practically the entire application focuses on software that records hours records for specific matters. Thus, the preamble recitation of a "matter management system" is a patentably distinct limitation. Tomiyasu has nothing whatever to do with matter management systems, and the rejections based upon Tomiyasu should therefore be withdrawn.

On the other hand, the applicant wants to push this matter forward to completion as soon as possible. The priority date is already many years in the past. Thus, even though it is completely unnecessary to do so, the applicant amends claim 1 (and its dependencies) to expressly recite a program code that records hours records for individual matters. The remaining claims already contain (expressly or by virtue of their dependencies) elements directed to matters. There is no possible way that those claims can be properly rejected over Tomiyasu. The Office should note that express inclusion of this limitation was not made by the applicant to overcome any prior art. The limitation was already included in the term "matter management system", and express recitation of matters is merely being made to push forward a very old matter, in the face of a completely unjustified rejection by the Office.

Obviousness

The Office rejected claims 2-11, 13-17, and 20 as being obvious over Tomiyasu. Those rejections are also entirely inappropriate.

First of all, it is logically impossible to reject a dependent claim as being obvious if the corresponding independent claim is not also deemed to be obvious. Thus, all of the rejections based upon obviousness are inappropriate. It is contemplated, however, that the Office was merely cutting corners, and would have rejected all pending claims as being obvious over Tomiyasu once it appreciated that the anticipation rejections were inappropriate. Assuming that to be the case the applicant will respond accordingly.

The Office asserts that one of ordinary skill in the art would have considered claims 2-11, 13-17, and 20 to have been obvious to one of ordinary skill in the art. But there is no argument, only the bald statement of the rejection. This is not a proper rejection. The Office cannot simply waive its hands and magically assert obviousness.

To properly assert an obviousness rejection the Office must set forth a *prima facie* case, which among other things requires that the Office identify specific teachings in the prior art that would have led one of ordinary skill in the art to assemble the claimed combination of limitations. Note that the teaching must be specific, and those teachings must be in the prior art. Here, the Office absolutely and completely failed to do either.

This is not even a case where the Office used impermissible hindsight to cobble together references that could together contain the elements of the claims. The Office provided no argument at all. The only cited reference is Tomiyasu, and that reference is missing almost all of the elements of all of the claims. There is just no possible way that the Tomiyasu reference, which deals with an onboard computer clock, teaches, suggests, or motivates one of ordinary skill in the art to do anything at all with respect to a matter management system.

The current office action cannot even be characterized as a feeble attempt to establish a *prima facie* case of obvious. In this case the Office made no attempt at all to establish a *prima facie* case of obviousness. All of the extant rejections must be withdrawn.

Respectfully submitted,
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VERSIONS WITH MARKING TO SHOW CHANGES MADE

In the Claims

1. A matter management system at least partially stored on a computer readable medium comprising a program code that records hours records for individual matters, and at least one feature selected from the group consisting of: (a) a single display that shows matter identification information, a plurality of milestones, a plurality of hourly billing descriptions, and a plurality of calendared items; (b) a user-defined on-line procedures mechanism accessed by selection of a milestone of the plurality of milestones; (c) a matter specific timer based reminder mechanism; and (d) a plurality of identifier/value pairs for storing data.